

REMARKS

Claims 2 - 6 have been withdrawn as drawn towards unelected species. Claims 7 - 11 have been added. Accordingly, claims 1 and 7 - 11 are presently being considered and claims 1 - 11 are presently pending.

I. The Drawings

Submitted herewith please find two (2) sheet(s) of drawings in compliance with 37 C.F.R. § 1.84. The Examiner is respectfully requested to acknowledge receipt of these drawings. The submitted drawings incorporate the proposed drawing changes approved in Paper No. 8.

II. Claim Rejection Under 35 U.S.C. § 103(a) in Light of U.S.P. Nos. 6,226,118 (Koyama) and 4,710,000 (Spitznas)

Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Koyama in view of Spitznas. For the following reasons, this rejection is respectfully traversed.

The Combination is Improper as it Renders the Prior Art Unsatisfactory for its Stated Purpose (M.P.E.P. §§ 2143.01; 2145)

If a proposed modification renders the prior art unsatisfactory for its stated purpose, then there is no suggestion or motivation to make the proposed amendment. The grounds of rejection state that it would be obvious to combine Koyama and Spitznas to arrive at the present invention. However, combining Koyama with Spitznas would render the prior art unsatisfactory for its stated purpose and is therefore improper. *See* M.P.E.P. §§ 2143.01; 2145.

By way of explanation, Spitznas cannot be combined with Koyama without destroying the intended functionality of Spitznas. Notably, Spitznas discloses a stereomicroscope of small design for use during surgery. Clearly the small design of Spitznas fulfills two purposes: (1) so that the microscope is lightweight and (2) so that the microscope is not bulky. (*See* Figures 6 and 9.) Both of these reasons fulfill a stated functionality of Spitznas, as explained below.

If Spitznas were bulky (as in the case of combining Spitznas with Koyama), the resultant microscope would clearly lose the stated function of enhanced ergonomics, which, according to Spitznas at Column 3, lines 45 - 48, is “absolutely necessary for stereomicroscopes which are used for surgery, since . . . only in an ergonomical respect [can] surgery . . . be carried out in a satisfactory manner.” In view of this, adding the massive, multiple revolving lens system of Koyama would add not only bulk, weight and obstruction to the system of Spitznas, it would also destroy the ergonomics necessary for safe and successful surgery. (*See* Figures 1, 18 and 19 of Koyama and compare to Figures 6 and 9 of Spitznas.) Accordingly, the attempted combination is improper. *See* M.P.E.P. §§ 2143.01; 2145.

Even if Combined, the Combination is Deficient by Not Teaching All of the Claim Limitations of the Instant Invention (See M.P.E.P. § 2143.03)

Additionally, assuming *arguendo* that Koyama *could* somehow be properly combined with Spitznas, the end invention would not teach all of the elements of the present invention, as required by M.P.E.P. § 2143.03. To wit, neither reference teaches or suggests the ability to shift between a stereo objective and a compound objective as does the present invention. (As an aside, “objective” is a common term of art in the microscopy arts, meaning the lens closest to the

object being studied in a microscope. Additionally, a “stereo” objective produces a 3-D picture whereas a “compound” objective produces a 2-D picture. Such terms are well defined and commonly used in the art.)

The grounds of rejection compare the instant invention’s ability to shift between viewing 2-D and viewing 3-D to Koyama’s compound lens revolving system in combination with the surgical stereoscope of Spitznas. However, neither reference teaches or suggests being able to shift between 3-D and 2-D. This element is important in that the present application is not just concerned with shifting between low magnification and high magnification (as is Koyama) or in providing only a surgical stereoscopic device (as is Spitznas). Rather, the present application teaches the ability to shift between 3-D and 2-D in the same microscope.

The references’ deficiencies are clearly seen in that the previously noted elements of the present invention allow a user to analyze the same sample in either 3-D or 2-D without having to remove the sample to two different microscopes. The time and labor saved alone are clear advantages over the prior art. Comparatively, the deficient teachings of the references fail to teach or suggest the ability to analyze a sample in both 3-D and 2-D without having to move the sample to different microscopes. For these reasons, Applicants respectfully assert that claim 1 recites features that are altogether absent in Koyama, Spitznas or any combination of the two, and therefore the Examiner is respectfully requested to reconsider and withdraw this rejection.

New Claims

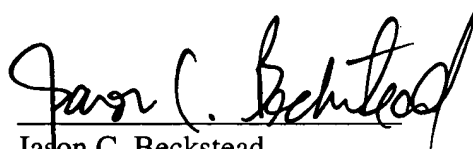
As to new claims 7 - 11, such claims are patentable at least for reasons analogous to the reasons finding claim 1 patentable. That is, the claims recite the ability to shift between 2-D and 3-D, a feature altogether absent in either Koyama or Spitznas.

III. Conclusion

For the reasons discussed above, Applicants respectfully assert that claims 1 - 11 are patentable. In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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AMENDMENT UNDER 37 C.F.R. § 1.116
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